

HP Docket No. 10990102-1

**REMARKS**

Applicants appreciate the Office's review of the present application. In response to the Office Action, the cited references have been reviewed, and the rejections and objections made to the claims by the Examiner have been considered. The claims presently on file in the present application are believed to be patentably distinguishable over the cited references, and therefore allowance of these claims is earnestly solicited.

In order to render the claims more clear and definite, and to emphasize the patentable novelty thereof, claim 33 has been amended. Accordingly, all claims presently on file in the subject application are in condition for immediate allowance, and such action is respectfully requested.

**Rejections****Rejection Under 35USC Section 112 Second Paragraph**

Claim 18 has been rejected under 35 USC Section 112, subparagraph 2, as being indefinite for failing to particularly point and distinctly claim the subject matter which the Applicant regards as the invention.

As to claim 18, the specification has been amended at page 6 to overcome this rejection. Support for this amendment is provided by claim 18 as filed.

In view of the foregoing, it is submitted that the rejections under 35 USC Section 112, paragraph 2, have been overcome and should be withdrawn.

**Rejection Under 35USC Section 102(e)**

Claim 33 has been rejected under 35 USC Section 102 (e), as being anticipated by U.S. patent 6,646,764 to Wataya. Applicants respectfully traverse the rejection and request reconsideration based on the amendment to claim 33.

Independent claim 33 (amended) is patentably distinguishable over the cited reference because claim 33 emphasizes the novel features of the present invention which enable the

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validity of a forensic marking to be determined. In this regard, claim 33 specifies:

“33. A method for printing a forensically marked image on a print medium with a swath printer, comprising:

obtaining a swath of image data corresponding to a source image;

if more than a threshold amount of color data exists in the swath of image data, superimposing onto the image data a swath of at least one forensic marking having an encoded pattern of image pixels in graphical form, the forensic marking including a checksum marker indicative of forensic marking validity;

printing the image data on the print medium so as to generate a swath of the forensically marked image; and

repeating the obtaining, superimposing, and printing until all the swaths of image data are printed.”

The novel features of the present invention are not anticipated by the Wataya reference in that the essential element of a forensic marking that includes a checksum marker indicative of forensic marking validity is absent from the Wataya reference. Therefore, the rejection has been overcome at least for this reason and should be withdrawn.

#### Rejection Under 35 USC Section 103

Claim 34 has been rejected under 35 USC Section 103 (a), as being unpatentable over U.S. patent 6,646,764 to Wataya in view of U.S. patent 5,539,539 to Fujimoto et al. (“Fujimoto”). Applicants respectfully traverse the rejection and request reconsideration.

Dependent claim 34 is allowable based on the allowability of independent base claim 33, as has been discussed heretofore.

Therefore, applicants respectfully traverse the Office’s assertion that it would have been obvious to a person of ordinary skill in the art at the time the invention was made to include the claimed features of Applicants’ invention. Such could be possible only in hindsight and in light of Applicants’ teachings. Therefore, the rejection is improper for at least for these reasons and should be withdrawn.

#### Formalities

#### Comments on Statement of Reasons for Allowance

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Applicants acknowledge, with appreciation, the allowance of claims 1-17, 19-32, and 35-37.

Applicants agree with the Office's conclusion regarding patentability, without necessarily agreeing with or acquiescing in the reason(s) set forth in the Office Action. In particular, applicant wishes to emphasize that the patentability of claims stems from the respective combinations of elements defined by the claims, each viewed as a whole, rather than the presence of any particular element(s) in the combinations. Applicants submits that the indicated claims are allowable because the prior art fails to anticipate, teach, suggest, or render obvious the invention as claimed, independent of how the invention is paraphrased. Applicant thus relies on the claims, as drafted, rather than any characterization in the Office Action.

#### **Conclusion**

Attorney for Applicants has carefully reviewed each one of the cited references made of record, and believes that the claims presently on file in the subject application patentably distinguish thereover, either taken alone or in combination with one another.

Therefore, all claims presently on file in the subject application are in condition for immediate allowance, and such action is respectfully requested. If it is felt for any reason that direct communication with Applicant's attorney would serve to advance prosecution of this case to finality, the Examiner is invited to call the undersigned Robert C. Sismilich, Esq. at the below-listed telephone number.

#### **AUTHORIZATION TO PAY AND PETITION FOR THE ACCEPTANCE OF ANY NECESSARY FEES**

If any charges or fees must be paid in connection with the foregoing communication (including but not limited to the payment of an extension fee or issue fees), or if any overpayment is to be refunded in connection with the above-identified application, any such charges or fees, or any such overpayment, may be respectively paid out of, or into, the

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Deposit Account No. 08-2025 of Hewlett-Packard Company. If any such payment also requires Petition or Extension Request, please construe this authorization to pay as the necessary Petition or Request which is required to accompany the payment.

Respectfully submitted,



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6/16/04

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